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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/807,285	06/19/2001	Vincent Wilmet	S-98/24	6029

23416 7590 10/20/2003

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EXAMINER

PRICE, ELVIS O

ART UNIT	PAPER NUMBER
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1621

DATE MAILED: 10/20/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/807,285

Applicant(s)

WILMET ET AL.

Examiner

Elvis O. Price

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 April 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 11-32 is/are pending in the application.
- 4a) Of the above claim(s) 22-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All   b) ☐ Some \*   c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5,10,14.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

Newly submitted claims 22-32 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Prior art anticipating or rendering obvious the invention of claims 11-21 would not necessarily anticipate or render obvious the invention of claims 22-32. Thus, an undue burden of search would be required to prosecute the two distinct inventions.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 22-32 have been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Information Disclosure Statement***

The information disclosure statements, filed 06/25/01, 7/8/02 and 4/17/03, comply with the provisions of 37 CFR 1.97, 1.98 and MPEP02 § 609. They have been placed in the application file, and the information referred to therein has been considered as to the merits.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 11-17 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Galland et al. {US Pat. 5,600,039}.

Galland et al. disclose a catalyst based on chromium oxide and no ammonium salt and a process for the catalytic hydrofluorination of 2-chloro-1,1,1-trifluoroethane comprising reacting 2-chloro-1,1,1-trifluoroethane with hydrogen fluoride, in the gas phase, to produce 1,1,1,2-tetrafluoroethane (see abstract and Example 2).

Claims 11-18 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Nappa et al. {US Pat. 5,475,167}.

Nappa et al. disclose a catalyst based on chromium oxide and no ammonium salt and a process for the catalytic hydrofluorination of chlorotetrafluoroethane comprising reacting chlorotetrafluoroethane with hydrogen fluoride, in the gas phase, to produce pentafluoroethane (see abstract and Col. 4, lines 28-49).

Claims 11-17 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Bonniface et al. {US Pat. 5,672,786}.

Bonniface et al. disclose a catalyst based on chromium oxide and no ammonium salt and a process for the catalytic hydrofluorination of dichloromethane comprising reacting dichloromethane with hydrogen fluoride, in the gas phase, to produce difluoromethane (see Example 1 and Table 1).

### ***Response to Arguments***

Applicant's arguments with respect to claims 11-21 have been considered but are moot in view of the new ground(s) of rejection.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elvis O. Price whose telephone number is 703 605-1204. The examiner can normally be reached on 8:30 am to 5:00 pm; Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter can be reached on 703 308-4532. The fax phone numbers for the organization where this application or proceeding is assigned is 703 308-4556 for regular communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-1235.

Elvis O. Price

October 10, 2003

  
JOHANN RICHTER  
SUPERVISORY PATENT EXAMINER  
GROUP 1621